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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,394	08/30/1999	JOHN S. YATES JR.	30585/3	9093

7590 03/12/2003

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EXAMINER

ELLIS, RICHARD L

ART UNIT PAPER NUMBER

2183

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

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Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run 5 months or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed 3/04/2003 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:
1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
  - c. ☐ They raise the issue of new matter. (See Note).
  - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☐ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:
- Claims allowed: \_\_\_\_\_
- Claims objected to: \_\_\_\_\_
- Claims rejected: \_\_\_\_\_
- However;
- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_
4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See attached
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.
- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

RICHARD L. ELLIS  
PRIMARY EXAMINER

1. This is in response to applicant's **second** request for withdrawal of finality of the last office action, received March 9, 2003.
2. Summary: Applicant's request is not convincing, the final rejection **stands**, and the shortened statutory period set in paper number 11 **remains** in effect and is set to expire April 1, 2003.

Detailed Explanations:

3. Point 1: That the claimed "necessarily disjoint" is different from the reference's "may overlap".

Applicant is referred to Webster's Ninth New Collegiate Dictionary, Merriam-Webster, Inc., 1990 which states:

"necessarily 1: of necessity 2: as a logical result or consequence"

Therefore, when the regions of Richter do not overlap, they are "necessarily disjoint" as a "logical result or consequence" of not overlapping.

4. Point 2: That obviousness requires a "reasonable expectation of success".

This is a repeat of the argument put forth in applicant's prior request, and as such, applicant is referred to the examiner's comments in the prior response. Additionally, it is pointed out to applicant that the requirements for obviousness are set forth in MPEP § 706.02(j). The criteria therein having been set forth, a prima facie case of obviousness has been made.

Additionally, it should be pointed out to applicant that MPEP § 2143.02 states that applicants are to submit evidence (i.e., in the form of a rule 131 affidavit), not assertions, to show lack of an expectation of success in order to overcome an obviousness rejection on these grounds.

5. Point 3: That the rejection of February 2002 makes no showing that the "altering a data storage content of the computer" of claim 22 is ... shown in Richter".

Applicant is referred to the first office action [paper number 8 mailed February 20, 2002], paragraph 7, subpart D, as well as paragraph 13 where this argued feature was

referenced in the first office action. Since the first office action was incorporated into the second office action, see paragraph 7 of paper number 11, mailed October 1, 2002, this limitation was in fact addressed in both office actions.

6. Point 4: That applicant's amendment to claim 22 merely included language from the parent claim.

Applicant's attention is drawn to applicant's own remarks on page 3 of the request:

"But claim 1 recites two alternatives" ... "[claim 22 was amended] into independent form for the sole purpose of bringing this limitation [data storage content altering] to the Examiner's attention"

By applicant's own admission, claim 1 recites an alternative, therefore, by amending claim 22 to contain only one of those two alternatives, a change in scope of claim 22 occurred by applicant's amendment. Therefore, finality was proper for this reason alone.

Additionally, as pointed out in paragraph 5 above, the limitation which was amended into claim 22 was already addressed in both the first and second office actions, and as such, rejection of claim 22 was additionally proper for this reason as well.


7. The shortened statutory period for reply set in the final rejection, paper number 11, mailed October 1, 2002 remains in effect and is set to expire on April 1, 2003.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (703) 305-9690. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (703) 305-9712. The fax phone numbers for this Group are: After-final: (703) 746-7238; Official: (703) 746-7239; Non-Official/Draft: (703) 746-7240.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Richard Ellis  
March 12, 2003

  
**Richard Ellis**  
**Primary Examiner**  
**Art Unit 2183**